

In support of the Restriction Requirement, the Examiner alleges that the subject matter defined by the claims represents two separate inventions. According to the Examiner, Groups I and II are related as process of making and the product made therefrom. The Examiner further alleges that the subject matter in Groups I and II have different classifications and requires separate and distinct searches.

In order to be fully responsive to the Examiner's requirement for restriction, applicants provisionally elect, with traverse, the subject matter of Group II, Claims 14-36. Moreover, the applicants reserve the right to file a divisional application directed to the subject matter of the remaining non-elected claims present in the application.

However, pursuant to 37 C.F.R. §§1.111 and 1.143, applicants hereby traverse the Examiner's requirement for restriction and request reconsideration thereof in view of the following remarks.

Applicants respectfully request that this restriction requirement be withdrawn since it is not in compliance with 35 U.S.C. §121 or 37 C.F.R. §1.141. 35 U.S.C. §121 provides that the Commissioner may restrict an application when, "two or more independent and distinct inventions are claimed in a single application." (Emphasis added). Similarly, 37 C.F.R. §1.141(a) permits restriction conditioned upon a finding that independent and distinct inventions are found within one application. Even assuming, pro arguendo, that the Examiner was correct in a showing of distinctiveness, there is absolutely no indication that the various classes are also independent. Therefore, in light of the foregoing statutory and regulatory criteria, the present restriction requirement cannot be maintained, since it lacks a

showing that allegedly several inventions are independent, one from the other.

Moreover, applicants submit that the allegedly separate inventions are not even as distinct as the Examiner has indicated, but rather represent one single inventive concept warranting their examination in a single application. Group I, i.e., Claims 1-13 and 37-44, is directed to a process of making C₆₀ and C₇₀ products, while Group II, i.e., Claims 14-36, is directed to the C₆₀ and C₇₀ products which can be prepared by the process described herein. Therefore these embodiments clearly define one single inventive concept.

Furthermore, the restriction requirement is not in compliance with the M.P.E.P. It is well established that the Examiner must provide reasoning on the record to support a Restriction Requirement. M.P.E.P. 808 states:

Every requirement to restriction has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the invention as claimed are either independent and distinct and (2) the reasons for insisting upon restriction....

Furthermore, in accordance M.P.E.P. §806.05(f), the Examiner must show that the inventions are distinct. Accordingly, the Examiner must show (1) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products or (2) that the product as claimed can be made by another and materially different process.

In the present case, the Examiner alleges that the inventions are distinct by concluding that the product can be made by another and materially different process. But, in the first instance, the Examiner has not met his burden. He has failed to show or provide sufficient reasoning in support of the restriction requirement as required by M.P.E.P. §808.05(f)

or 308. The Examiner merely concluded that the products can be made by a materially different process. In particular, the Examiner suggests that the product can be made by flame combustion of hydrocarbon-oxygen mixtures. However, the Examiner has not provided any reasoning in support thereof. The Examiner has not cited any references to support his hypothesis. Thus, the Examiner has not provided sufficient reasoning to support the Restriction Requirement, in accordance with M.P.E.P. §808 and has not provided the requisite showing in accordance with M.P.E.P. §806.05(f). Consequently, the Examiner has not complied with the requirements of the M.P.E.P. and accordingly, the restriction requirement should be withdrawn.

In the Office Action, the Examiner also seemed to suggest that a prior art search requiring a search in more than one classification is sufficient criteria for maintaining a restriction to patently distinct invention. This, of course, is error and simply does not comply with the provisions under 35 U.S.C. §121. (See, in re Kuehl, infra).

It should also be observed that a requirement for restriction is not mandatory under 35 U.S.C. §121 or 37 C.F.R. §1.142; it is merely discretionary. This observation is particularly important in light of the Court decisions which have indicated that an improperly made restriction requirement would not preclude a holding of double patenting, despite the language of 35 U.S.C. §121, third sentence. EverSharp, Inc. v. Philip Morris, Inc., 256 F. Supp. 778, 120 U.S.P.Q. 98 (E.D. Va. 1966), aff'd 374 F.2d 511, 153 U.S.P.Q. 91 (4th Cir. 1967). In addition, the Courts have recognized the advantages to the public interest to permit patentees to claim all aspects of their invention, as applicants have done herein, so as to encourage the patentees to make a more detailed

disclosure of all aspects of their discovery. The CCPA has observed:


We believe the Constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects of what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 475 F.2d 658, 666, 177 U.S.P.Q. 250, 256 (CCPA 1973).

Furthermore, applicants respectfully request that in view of increased Official Fees and the potential limitation of applicants' financial resources, a practice which arbitrarily imposes a restriction requirement may become prohibitive, and thereby contravenes the Constitutional intent to promote and encourage the progress of Science and the useful Arts.

Hence, it is once again respectfully requested that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Respectfully submitted,


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